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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/254,005	03/01/1999	TAKAFUMI ATARASHI	Q53451	6345

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SUGHRUE MION ZINN MACPEAK & SEAS
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WASHINGTON, DC 20037

EXAMINER

KRUER, KEVIN R

28

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/254,005

Examiner

Kevin R Kruer

Applicant(s)

ATARASHI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11 and 13 is/are allowed.
- 6) ☐ Claim(s) 1,3,5-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find support in the original specification for an embodiment in which the consolidated particles were used for a filter reflecting light having a specific angle.

Claim Rejections - 35 USC § 103

3. Claims 1, 3, 5, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beane et al (US 5,453,293) for reasons of record.
4. Claims 1, 3, 6-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paszkiet et al (US 5,716,552) for reasons of record.

Allowable Subject Matter

5. Claims 11 and 13 are allowable over the prior art.

Claim 11 is allowable over the prior art because the prior art neither teaches nor renders obvious a glass having optical anisotropy comprising a coated powder which has been subjected to heat treatment under pressure to consolidate the same, wherein said coated powder comprises a base particle made of semiconductor or a conductor

having thereon a glass film, and wherein said consolidated powder is three dimensionally arranged at the same distance from one another in a give direction.

Claim 13 is allowable over the prior art because the prior art neither teaches nor renders obvious a polarizing filter transmitting light having a specific angle comprising coated powders which have been subjected to heat treatment under pressure to consolidate the same, said coated powder each comprising a base particle having thereon a clear multilayer metal oxide film, wherein said consolidated powder is three dimensionally arranged at the same distance from one another in a give direction.

The closest prior art is Beane (US 5,453,293), but Beane does not teach that the particles may have a glass film or that the consolidated material may be utilized as an anisotropic glass or a polarizing filter. Thus, the claims are allowable.

Response to Arguments

6. Applicant's arguments filed September 23, 2003 have been fully considered but they are not persuasive.

With respect to the rejection of claims 12 and 13 as being rejected under 35 U.S.C. 112, first paragraph, Applicant argues that the embodiments are supported by the original disclosure. After reviewing the specification, the examiner agrees that claim 11 is supported by embodiment (3) on page 20.

With respect to claim 12, the examiner maintains the position that the claim is not supported by the original specification. Applicant points to page 5 of the specification for support, but the disclosure does not support the broader embodiment claimed. Furthermore, there is no disclosure that the embodiment on page 5 results in a filter

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reflecting light having a specific angle. Applicant argues that the property is inherent to the embodiment disclosed. However, the examiner reminds applicant that argument cannot take the place of evidence. Since the claimed embodiment is broader than the embodiment disclosed and there is no evidence supporting Applicant's conclusion that the properties are inherent to the embodiment disclosed, the rejection of claim 12 is maintained.

With respect to the rejections based upon Beane and Paszkiet, Applicant argues that the invention has no voids between particles. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no voids between the particles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that the voidless arrangement of particles is inherent to glass embodiments because voids would cause light to be scattered at random (see page 8, first paragraph of paper #27). However, the claims are limited to glass embodiments. Furthermore, Applicant's arguments do not take the place of evidence. Thus, Applicants arguments are not persuasive.

Applicant further argues that Beane does not explicitly teach that the consolidated particles are three dimensionally arranged. However, the figures show that the particles are three dimensionally arranged. MPEP2125 teaches that drawings

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and pictures can anticipate claims if they clearly show the structure which is claimed.

Thus, the rejection is maintained.

Applicant further argues that Beane does not teach a magnetic embodiment.

The examiner respectfully disagrees. Beane teaches that the particle may comprise KOVAR alloy. KOVAR is known in the art to be magnetic (See US 4,076,955; col 1, lines 55+).

With respect to the rejection based upon Paszkiet, Applicant argues that the composition taught in Paszkiet is not molded. However, the examiner notes that the courts have held that the method of making a product does not patentably distinguish the claimed product from a product taught in the prior art unless it can be shown that the method of making the product inherently results in a materially different product. In the present application, no such showing has been made. Thus, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

K-RK
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Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700